REJECTION UNDER 35 U.S.C. § 112

In the Office Action, at page 2, claims 6 and 11 were rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth therein. These claims have been amended to remove any ambiguity (claim 6) and to provide proper antecedent basis (claim 11). Withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 101

In the Office Action, at page 2, claim 21 was rejected under 35 U.S.C. § 101 as allegedly lacking utility. This rejection is traversed and reconsideration is requested.

Claim 21 was rejected as allegedly lacking utility. The Examiner reasoned that "In claim [sic] addressed to an apparatus, such as a computer readable storage medium, 'a process' for doing something has no patentable weight because it is not a physical structure." However, the Commissioner now states "that computer programs [e.g. a process] embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103." (In re Beauregard, 35 USPQ 2d 1383, 1384 (Fed. Cir. 1995)). Furthermore, MPEP § 2106, IV, B, 1, states that "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." A computer medium storing a process is clearly patentable subject matter and cannot lack utility on that basis alone. Withdrawal of the rejection of claim 21 is respectfully requested.

PRIOR ART

Myers discusses a system for managing medical records. Patient data is stored in data servers and is accessed by workstations. Encounter records are complete in themselves. Myers discusses a single system that initiates a patient lookup, retrieves all records of the patient, retrieves header information from a master catalog, verifies the records, assembles the records, and retrieves related images (documents). A single program on a workstation performs these steps and displays the results.

PRESENT INVENTION

The present invention is addressed to a system for integrating two existing legacy systems. By adding an integration interface to an existing healthcare system to integrate a

document system, users may seamlessly access both systems. By integrating two existing and separate systems, the present invention improves the value of the existing systems without significant overhead or expense. The existing system is improved in that patient records and patient documents (e.g. a chart document, a text document, an image document, a voice document, a spread sheet document, audio, video, etc. (spec. pages 6-7)) can be conveniently and simultaneously accessed within one integration interface. Myers does not discuss integrating separate systems, but rather discusses a single system.

REJECTION UNDER 35 U.S.C. § 102

In the Office Action, at pages 2-4, claims 1, 4-9, and 11-20 were rejected under 35 U.S.C. § 102 as anticipated by Myers. This rejection is traversed and reconsideration is requested.

Claim 1 recites "an integration interface" that integrates separate systems by "including modifications to the user interface of said healthcare system" through which patient records are accessed, and in the same interface "allowing a request for access to a patient document". Myers does not discuss this integration interface feature because Myers discusses only an interface to a single system; there is nothing to integrate. Furthermore, Myers gives no indication of needing to modify an interface. Claim 1's integration interface is not discussed or suggested by Myers and withdrawal of the rejection of claim 1 is respectfully requested.

Claims 1, 14, 15, 17, and 18 recite "a document management system separate from said/the healthcare system". The Examiner alleged that "physically separate" workstations and server 10, 12, 14, and 16 in Myers are analogous. However, the claims do not recite "physically separate", but rather recite separate *systems*. Myers discusses a single system that includes document and record information. Furthermore, the workstations are not "healthcare management systems" because they are merely front-ends for interfacing the data in the servers (alleged document system). The workstations are also not healthcare systems because they do not store or manipulate patient records; instead, they use a central controller 130 to access various databases (see Fig. 6). Withdrawal of the rejection of claims 1, 14, 15, 17, and 18 is respectfully requested.

Claim 14 has been amended to emphasize that its healthcare and document systems, as discussed above, are separate. Claim 14, as amended, recites a "a document management system separate from said healthcare system and providing <u>an application programming</u>

interface separate from and used by said healthcare system to access [to] patient documents".
Myers does not discuss or suggest such a feature and withdrawal of the rejection of claim 14 is
respectfully further requested.

Claims 1 and 14 recite "a healthcare system providing access *limited* to patient records".
The Examiner, in rejecting claim 1, alleged that Myer's workstations correspond to "a healthcare
system providing access limited to patient records". The Examiner left out "limited", stating
instead that Myers discloses "a set of workstations which provides access to patient records". It
is respectfully pointed out that MPEP § 706.02(j) requires "the prior art reference (or references
when combined) must teach or suggest all the claim limitations." In this case, "limited" indicates
that the healthcare system accesses patient *records*. Newton's Telecom Dictionary defines a
record as "a group of related data items treated as one unit of information - for example, your
name, address and phone number." The alleged health care system in Myers (workstations)
clearly provides access to images, which are not "records", and therefore the workstations
provide access to information that is not *limited* to patient *records*.

The workstations in Myers are for "retrieving and processing data from the servers 10-
16" (col. 4, lines 8 and 9). Server 12 is an *image* server that is included in servers 10-16 that are
accessed by the workstations. Thus, the workstations do not provide access limited to patient
records; they provide access to image data. This is also shown by the Main window in the
workstations, which displays 7 encounter types, including encounter type (5) Imaging Studies
(col. 4, lines 47-53). "The Imaging Studies encounter type includes *image data such as x-rays,
cardiovascular scans, ultrasound scans* and so on." (col. 4, lines 63-65). Again, the Examiner
alleged that Myer's workstations correspond to claim 1 and 14's "healthcare system providing
access limited to patient records", and yet the workstations clearly provide access to images,
which are not records. Withdrawal of the rejection of claims 1 and 14 is respectfully requested.

Claims 19 and 20 recite "a non-integrated document management system providing
access to patient documents". At page 3, line 4 of the Office Action, the Examiner alleged that
servers 10, 12, 14, and 16 in Myers correspond to a "non-integrated document management
system". In contrast, Myers teaches a single system; "The headers and transcriptions (which
form the body of the encounter record) are collected in blocks 86 and 88 respectively and
associated headers and bodies are brought together to form a **unified encounter record** in
block 90" (col. 9, lines 23-26). Myers is also shown to be a single unified
document/management system with reference to Fig. 5. Fig. 5 shows "the chart assembly

process" during a patient lookup. "If an image is available for one or more of the encounter records ... then the information for retrieving the image from the image server 12 is retrieved" (col. 10, lines 22-25). In other words, documents and patient records in Myers are part of a single encounter-record in a single system. This clearly contradicts claims 19 and 20, which recite "*non-integrated* document management system". Withdrawal of the rejection of claims 19 and 20 is respectfully requested.

Claim 15 recites "a healthcare system including a document control *added thereto and not originally available in said healthcare system*". This feature is significant because the present invention addresses enhancing existing healthcare systems with seamless, integrated document management, by using an application interface that does not require extensive recoding or redesign of the existing system. Myers, as discussed above, is a single, unified system, and does not disclose an original system being added to. Claim 15 was rejected without comment, and without reference to any prior art allegedly teaching this feature. Withdrawal of the rejection of claim 15 is respectfully requested.

Similarly, claim 17 recites "using an access object *not available in said healthcare system*". Again, this feature was not discussed in the Office Action and is not present in Myers, which teaches a unified healthcare system, where all objects are present in the same system. Withdrawal of the rejection of claim 17 is respectfully requested.

Regarding claims 1 and 20, the Examiner gave "No patentable weight ... to the process defined in claims 1 and 20, since these claims are addressed to an apparatus and not a method." This ground for rejection is clearly contrary to the law. It was stated in Ex parte Murray, 9 USPQ 2d 1819, 1821 (B.P.A.I. 1988), that "an apparatus or system capable of performing a business function may comprise patentable subject matter". Furthermore, it was stated in Ex parte Stanley, 121 USPQ 621, 627-28 (Pat. Off. Bd. App. 1958) that "the term 'device' coupled with a function is a proper definition of structure and is therefore within the requirements of 35 USC 112, last paragraph". Because the Examiner acknowledged that no patentable weight was given to the "process" in claims 1 and 20, and because all claim limitations must be taught by the prior art, the rejection of claims 1 and 20 must be withdrawn. Withdrawal of claims 1 and 20 must be withdrawn. Such withdrawal is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

In the Office Action, at pages 4 and 5, claims 2 and 3 were rejected under 35 U.S.C. §

103 in view of Myers. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claim 2 recites "a user logs-on to *the healthcare system* using the user interface and said integration interface logs-on to the *management system* using information from the user interface". The Examiner alleged that this feature is obvious in view of Myers. The Examiner compared network log-on to healthcare system and management system log-on. Logging on to a network from a workstation is clearly not the same as logging on to a healthcare system or a management system; healthcare systems and management systems are substantially different that networks and workstations per se. Laws protecting the privacy of healthcare records make carte blanche network-like log-on problematic because a user might have permission to log-on to a workstation but might not have permission to log-on to a given healthcare system. A person logging on to a workstation would not, in the Examiner's words "log-on to a network [or healthcare system] as a conventional start-up practice", because the user may not have authority to access the healthcare system. Withdrawal of the rejection of claim 2 is respectfully requested.

Further regarding the rejection of claim 2, the Examiner is supporting the rejection by stating that the log-on feature is "well known in the art". This is basing the rejection on the personal knowledge of the Examiner. The personal knowledge of the Examiner when used as a basis for a rejection must be supported by an affidavit as to the specifics of the facts of that knowledge when called for by applicant. See, e.g. 37 C.F.R. § 1.104(d)(2). In short, the rules of the U.S. Patent and Trademark Office do not allow discretion on the part of the Examiner. Either the Examiner must support this assertion with an Affidavit or withdraw the rejection. In view of the special circumstances involved with healthcare systems, the Examiner is respectfully requested to support the rejection of claim 2 with either an affidavit or a reference, or withdraw the rejection.

Claim 3 was rejected on the same grounds as claim 2. Although these claims recite different features, the arguments regarding claim 2 are equally applicable. Withdrawal of the rejection of claim 3 is respectfully requested.

DEPENDENT CLAIMS

Dependent claims 4-10, 11-13, and 16 are deemed patentable due at least to their depending from allowable independent claims. These claims are also patentable due to their

recitation of independently patentable features. For example, claim 4 recites "document <u>element</u> deficiency information" where "said integration interface controls the management system to perform deficiency updates". Myers does not address missing elements from a chart (e.g. a missing signature). Withdrawal of the rejection of claims 4-10, 11-13, and 13 is respectfully requested.

NEW CLAIM 22

New claim 22 has been added to emphasize another aspect of the presently claimed invention. Claim 22 recites a method of integrating a healthcare system with a patient document management system to that produce an integration interface similar to that of the previously pending claims. Claim 22 is patentable due at least to its distinguishing recitation of an application program interface incorporated into an existing application. Allowance of claim 22 is respectfully requested.

CONCLUSION

In accordance with the foregoing, claims 4, 6, 11, and 14 have been amended. Claim 22 has been added. Claims 1-22 are pending and under consideration.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please AMEND the following claims:

4. (ONCE AMENDED) An access system as recited in claim 1, wherein a user inputs document <u>element</u> deficiency information using the user interface and said integration interface controls the management system to perform deficiency updates responsive to the <u>document element</u> deficiency information.

6. (ONCE AMENDED) An access system as recited in claim 1, wherein said <u>integration</u> interface displays documents from said document management system.

11. (ONCE AMENDED) An access system as recited in claim [1] <u>8</u>, wherein said objects comprise a query object.

14. (ONCE AMENDED) A patient records and document access system, comprising:
a healthcare system providing access limited to patient records through a user interface;
a document management system separate from said healthcare system and providing <u>an application programming interface separate from and used by said healthcare system to</u> access [to] patient documents; and
an integration interface including modifications to the user interface of said healthcare system allowing a request for access to a patient document and viewing of patient documents.

Please ADD the following claims:

22. (NEW) A method for integrating an existing healthcare system with an existing patient document management system, comprising:

adding an application program interface (API) to the existing patient document management system, with the API providing application-level access to the patient document management system;

incorporating into an existing interface of the existing healthcare system objects of the API, including a GUI control, a query manager, and a logon manager, with the logon manager

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using logon information shared with the existing interface to automatically authenticate a user of the patient document management system; and

displaying a view of patient information in the healthcare system while simultaneously displaying in the GUI control a view of a document corresponding to and responsive to the patient information, and retrieved by the query manager.